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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,124	01/09/2002	Franz Kunisch	MO-6598/LEA 33,210	9416

34947 7590 02/03/2004

BAYER CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER

MCKANE, ELIZABETH L

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,124

Applicant(s)

KUNISCH ET AL.

Examiner

Leigh McKane

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 102102.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Claim Rejections - 35 USC § 102

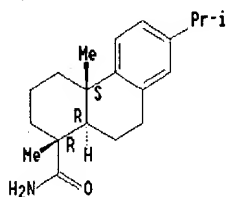
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 8-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by CAS Registry # 35928-32-6.

Registry # 35928-32-6 is the following compound, which was entered into the STN database on 16 November 1984:

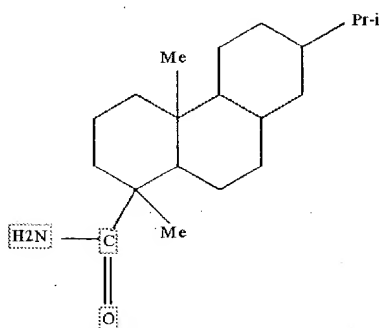


The above compound reads on the instant claims when the claimed formula is I8, when $n=0$ and wherein: R^1 is NR^2R^3 ; R^2 is a hydrogen atom; R^3 is $C=OR^4$; and R^4 is a hydrogen atom.

3. Claims 8-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by CAS Registry # 73757-72-9.

Registry # 73757-72-9 is the following compound, which was entered into the STN database on 16 November 1984:

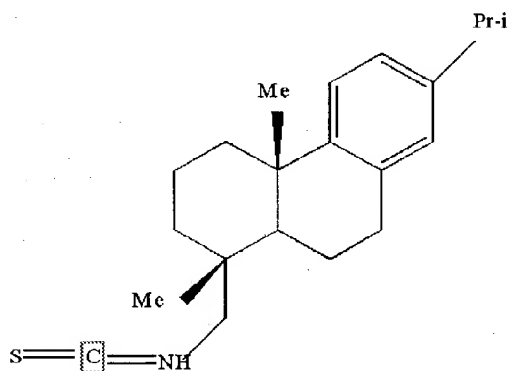
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The above compound reads on the instant claims when the claimed formula is I1 or I4, when $n=0$ and wherein: R^1 is NR^2R^3 ; R^2 is a hydrogen atom; R^3 is $C=OR^4$; and R^4 is a hydrogen atom.

4. Claims 8, 9, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by CAS Registry # 115269-93-7.

Registry # 115269-93-7 is the following compound, which was entered into the STN database on 16 July 1988:

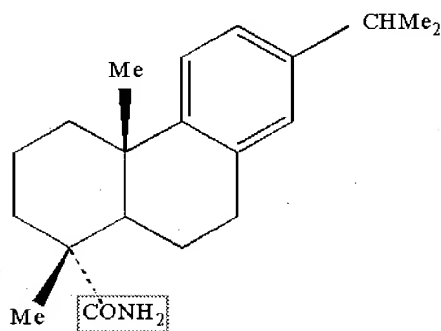


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The above compound reads on the instant claims when the claimed formula is I8, when $n=1$ and wherein R^1 is an isothiocyanate group.

5. Claims 8-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Akatsuka et al (abstract of JP 63-017806).

Akatsuka et al teaches that the compound below was known as of 25 January 1988.



The above compound reads on the instant claims when the claimed formula is I8, when $n=0$ and wherein: R^1 is NR^2R^3 ; R^2 is a hydrogen atom; R^3 is $C=OR^4$; and R^4 is a hydrogen atom.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 11-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al (U.S. Patent No. 5,236,493) in view of any of CAS Registry # 35928-32-6, CAS Registry # 73757-72-9, CAS Registry # 115269-93-7, or Akatsuka et al.

Hunter et al teaches the known use of rosin amines for the antifouling purposes claimed by the instant invention. The primary amine disclosed by Hunter et al in col.3, lines 5-15 is an analogue of those claimed by the present invention. One of ordinary skill in the art would have found it obvious to apply the rosin compounds of the prior art in the manner and purpose described by Hunter et al because one would have had an expectation of success in doing so due to similar chemical structures.

Claim Objections

9. Claim 1 is objected to because of the following informalities: Formulas I1 and I4 are duplicates. Appropriate correction is required.

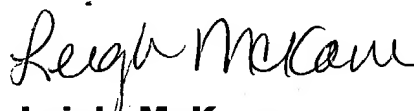
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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leigh McKane whose telephone number is 571-272-1275. The examiner can normally be reached on Monday-Wednesday (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 571-272-1275. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.



Leigh McKane
Primary Examiner
Art Unit 1744

elm
26 January 2004